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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
87/633,452	12/20/90	TULLIS	P31-8756

CAMPBELL AND FLORES  
4370 LAJOLLA VILLAGE DRIVE  
SUITE 700  
LAJOLLA, CA 92122

18N2/0729

EXAMINER MARTINELL, J	
ART UNIT	PAPER NUMBER
1885	17

DATE MAILED: 1885

07/29/93

NOTICE OF ABANDONMENT

This application is abandoned in view of:

- ☒ Applicant's failure to respond to the Office letter, mailed 12/16/92.
  - ☐ Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
  - ☐ Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
  - ☐ Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.
    - ☐ The issue fee was received on \_\_\_\_\_.
    - ☐ The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_.
- In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (l), and a verified showing as to the causes of the delay.
- If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513.
- ☐ Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.
    - ☐ The corrected and/or substitute drawings were received on \_\_\_\_\_.
  - ☐ The reason(s) below.

  
JAMES MARTINELL, PH.D.  
SENIOR LEVEL EXAMINER  
GROUP 1800

Serial No. 07/633,452  
Art Unit 1805

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Claims 40-43, 45-47, 49, 51, and 52 stand withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention. Election was made without traverse in Paper No. 9.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The disclosure is objected to because of the following informalities:

In the amendment filed January 9, 1992, the amendment to the first page of the specification misidentified the oldest parent application as Serial No. 07/314,214. The correct Serial No. is 07/314,124.

Appropriate correction is required.

Claims 53-61 and 63 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the preparation of stabilized forms of oligodeoxyribonucleotides that are phosphotriesters. See M.P.E.P. §§ 706.03(n) and 706.03(z). This rejection is repeated essentially for reasons already of record (e.g., Office action mailed April 1, 1992, page 2, third full paragraph). Applicant's arguments (paper no. 15, pages 3-4) and Exhibits A-E submitted with the response filed October 1, 1992 are not convincing. First, Exhibits A, B, and C were published subsequent to the effective filing date of the instant application. Applicant's argument that these articles ought to be convincing because they show the level of skill in the art at the time the invention was made is not convincing because of the rapid rate of developments in the field of chemical synthesis of

oligodeoxyribonucleotides in the early 1980s. Because of the rapid rate of development at that time, the level of skill in the art could change rapidly over a period of only a few months. Thus, the citation of articles published in 1982, 1983, and 1984 in order to establish a level of skill in the art of oligodeoxyribonucleotide synthesis in 1981 is not convincing. Second, applicant's arguments and Exhibits A-E are not sufficient to overcome this rejection because none of Exhibits A-E discusses what is crucial to the use of oligodeoxyribonucleotides in this invention. For example, none of the references discusses (a) the ability of the particular oligodeoxyribonucleotides of any of the references to get into cells, (b) the ability of the particular oligodeoxyribonucleotides of any of the references to hybridize effectively and specifically to a nucleic acid of interest (i.e. a target nucleic acid), or (c) the in vivo stability of any particular oligodeoxyribonucleotides of any of the references. Therefore, given the lack of guidance as to which types of oligodeoxyribonucleotides to use in the instant invention or even the mere mention of potential candidate oligodeoxyribonucleotides to use and the failure of applicant to establish that one of skill in the art would readily know which oligodeoxyribonucleotide to use in the absence of such a disclosure in the instant application, one of skill in the art would be compelled to undertake undue experimentation in order to practice the invention as claimed.

Claims 53-61 and 63 are rejected under 35 U.S.C. § 103 as being unpatentable over Itakura et al in view of either one of Paterson et al or Hastie et al in further view of either one of Summerton or Miller et al. This

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rejection is repeated essentially for reasons already of record (e.g., Office action mailed April 1, 1992, page 3). Applicant's argument (paper no. 15, pages 6-7) and Exhibits G-L submitted with the response filed October 1, 1992 are not convincing. Exhibits G-L do not establish that claims not limited to phosphotriesters were present in the parent application at a time when the obviousness rejection that corresponds to this rejection was not made. The record in the parent application indicates that the obviousness rejection that corresponds to this rejection was made as late as the Office action mailed on March 15, 1990 and was maintained in the Advisory action mailed on August 28, 1990.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.


Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CH1 Fax Center number is (703) 308-4227.

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Any inquiry concerning this communication should be directed to J.  
Martinell at telephone number (703) 308-0196.

Martinell

  
JAMES MARTINELL, Ph.D.  
PRIMARY EXAMINER  
ART UNIT 185 1805